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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,179	03/23/2001	Jeffrey Alan Meaden		7594

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,179

Applicant(s)

MEADEN, JEFFREY ALAN

Examiner

Sam Rimell

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-24 is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 7 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 6, 8, 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Baisley (U.S. Patent 6,502,112).

Claim 1: Baisley discloses a method which involves the sorting of two document. The content of each document is readable as a list, given that the claims do not define what the list actually contains. A processing system compares each of the documents, with comparison involving a sorting steps 22 or 26 performed on each document.

The documents are not sortable in their default format by reason that they must be parsed at steps 21 and 25. Therefore, the data retrieval method is a specific data retrieval method that involves parsing the documents from their default format in to a secondary format (in this case, a semantical graph). Following the specific data retrieval method of receiving and parsing the document, the content of the parsed document is then sorted at steps 22 or 26.

The step of calling a generic data retrieval method if the data items are sortable in their default format is recited as a conditional step, and is thus not necessarily limiting the claim.

Claim 2: The specific data retrieval method involves parsing the default documents 20 and 24 into a secondary format (a semantical graph) which permits the document to be sorted at steps 22 and 26.

Claim 5: Since the generic data retrieval method is recited as conditional, it is not necessarily limiting of the invention. Claim 5, like claim 1, asserts that the generic data retrieval method is conditional and not mandatory.

Claim 7: The sort/reorder functions 22 and 26 requests the data items in their sortable format, which is the parsed format, and is different from their original unparsed format.

Claims 3, 4, 6, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10-24 are allowed.

Remarks

Applicant's arguments and amendments have been considered.

Applicant argues that the two calling steps which are set forth in claim 1 are "binary options" and that both must be demonstrated in the prior art.

Examiner does agree that the calling options are "binary" in the sense that at least one of the two options must be exercised. However, Examiner does not agree that both must be demonstrated in the prior art.

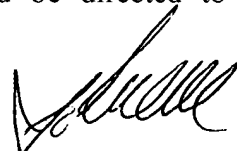
A critical consideration is the fact that the claimed invention is a set of method steps. The two calling steps are diametrically opposite method steps that only occur under diametrically opposite conditions. Both calling steps cannot occur at the same time, so that invention cannot be logically composed of both calling steps. One of the steps must therefore be optional. The prior art is only required to show steps that are mandatory and not steps that are optional.

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Accordingly, if the prior art demonstrates one of the two opposing, optional steps, it is considered anticipatory to those steps.

This action is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell
Primary Examiner
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